

REMARKS

In an office action dated 27 May 2004, the examiner rejects claims 1-19 (all pending claims). In response to the office action, Applicant amends claim 1 and respectfully traverses the rejections. Claims 1-19 (all pending claims) remain in the application. In light of the amendments and the arguments set forth below, Applicants respectfully request that the rejections be removed and the claims be allowed.

The Examiner rejects claims 119 under 35 U.S.C. §112(2) as being indefinite. Claim 1 has been amended to better define the term “natural hand” as any combination of two cards in a hand that occur less frequently than an Ace of any suit and a card of any suit having a value of ten. Thus, the term natural hand is more easily understood and the dependent claims do not contradict claim 1.

The Examiner rejects claim 1 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 6,019,373 issued to Brown (Brown) in view of U.S. Patent Number 5,735,524 issued to Wisted (Wisted). In order to maintain a rejection the Examiner has the burden of providing evidence of prima facie obviousness. See MPEP §2143. See also In Re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In order to prove prima facie obviousness, the Examiner must provide evidence in the prior art of a motivation to combine or modify a reference, a reasonable expectation of success, and a teaching of each and every claimed element. Id. The Examiner has failed to provide reference that teach each and every claimed element and has failed to provide evidence of a proper motivation to combine.

Amended claim 1 recites a step of “establishing a best hand called a Natural that beats all other hands and pays a bonus when it wins” and a limitation of “wherein any of said hands of the players that exceed 21 do not always lose responsive to said hands of said player being compared to said of said dealer.” Neither Brown nor Wisted teaches these limitations. Even if the combination of Wisted and Brown taught all of the limitations there is no motivation to combine the references.

Brown does not teach the establishing of a natural hand or that any hand exceeding 21 does not always lose responsive to being compared to the hand of the dealer. Instead, Brown teaches a game that combines the games of blackjack and craps. See Abstract. The game allows players having predetermined hands to roll two dice and win payouts based upon modified rules of craps. See generally Col. 3, line 42, - Col. 7, line 4. Brown then plays a normal game of blackjack without variations to the rules. See Col. 7, lines 6-10. The natural hands that the Examiner relies on in Brown are hands that win a player a roll of the dice. The natural hands cited do not beat other hands in a game of blackjack. Thus, Brown does not teach a natural hand that beats all other hands or where a player having a hand that exceed 21 does not always lose as these two limitations are contrary to the traditional rules of blackjack. Therefore, Brown does not teach the recited limitations.

Wisted also does not teach the recited limitations. Instead Wisted teaches a game like blackjack where players play against one another. In the Widsted game, each player tries to reach a point total the difference of the amount of each players hand from the point total is determined and the player or players with the lowest difference wins and is paid from the wagers of the losing players this point

total is typically 22, but may be another number. Thus, the winning hand is based upon comparison to all the other players and not to the hand of the dealer as recited in amended claim 1. Furthermore, Wisted is completely silent to specific combinations of cards that will beat all other hands. Thus, Wisted does not teach establishing of a natural hand as recited in amended claim 1.

Since neither Brown nor Wisted teaches establishing of a natural hand or that a hand total greater than 21 does not always lose when compared to the hand of the dealer, the combination of these references does not teach these limitations. For this reason, Applicant respectfully requests that rejection of claim 1 be removed and amended claim 1 be allowed.

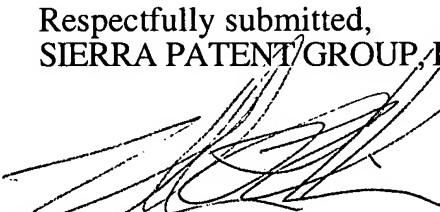
Furthermore, even if the combination of Brown and Wisted teaches each and every element of amended claim 1, the Examiner has not provided evidence of a proper motivation to combine. The Examiner has provided no motivation to do so as required by case law and the MPEP. See MPEP §2143. The Examiner is reminded that for a combination to be proper the proposed modification or combination cannot change the principle mode of operation of reference. See MPEP §2143.01. See also In re Ratti, 270 F2d. 810 (CCPA 1959). In this case a combination of Brown with Wisted would change the principle mode of operation of each. The purpose of Brown is to provide a game that combines craps and blackjack. The purpose of Wisted is to provide a game that is like blackjack except it may be played in jurisdictions that do not allow blackjack or a house dealer. The premises contradict one another. Brown is a game that tries to combine the excitement of two different games without varying the rules of the original games to allow players knowledgeable of the games to play. Wisted on the other hand is trying to provide a game that is similar enough to blackjack to

induce others to play while complying with the laws of certain jurisdictions. The combination of a dice game with the Wisted game may make the game illegal in the jurisdictions that Wisted is intended to be played in. Each of these games works perfectly fine for their intended purpose and one would not be motivated to combine the two for fear of negating the purpose each was intended for. Thus, there is no motivation to combine the references. Therefore applicant respectfully requests that the rejection to claim 1 be removed and that amended claim 1 be allowed

Claims 2-19 are dependent upon amended claim 1. Therefore, claims 2-19 are allowable for at least the same reasons as amended claim 1. Other arguments as to the allowability of claims 2-19 are moot. Applicants respectfully requests that the rejections of claims 2-19 be removed and claims 2-19 be allowed.

If the Examiner has any questions regarding this response or the application in general, the Examiner is invited to telephone the undersigned at 775-586-9500.

Respectfully submitted,  
SIERRA PATENT/GROUP, LTD.



William P. Wilbar  
Reg. No.: 43,265

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Sierra Patent Group, Ltd.  
P.O. Box 6149  
Stateline, NV 89449  
(775) 586-9500  
(775) 586-9550 Fax